

REMARKS

Applicant would like to thank the Examiner for a careful review of this application. In view of the above amendments and the included remarks, Applicant respectfully requests reconsideration of this application.

I. Disposition of Claims

Claims 8-17 are pending. Claims 8 and 14 are independent claims. Claims 9-13 and 15-17 are dependent claims. Claims 8 and 14 have been amended. These amendments were not made in view of prior art. The amendments are fully supported by the specification as originally filed. No new matter has been added.

II. Rejection under 35 U.S.C. § 101

Claims 8-17 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. To the extent that this rejection may still apply to the amended claims, the rejection is respectfully traversed.

The claimed invention as a whole comprises a display medium, such as, a paper or a computer screen including cells that display specific problems or achieve specific goals (subjects) as well as the solutions and/or actions to be taken (thought results) to solve the specific problems or achieve the specific goals (subjects).

As described in the specification the instrument of contemplation, in accordance with one embodiment of the invention, the medium for displaying words can include a paper on which the displaying cells are printed as shown in Figure 4 and described in page 7, lines 19-23 of the specification. The subject, or thought results, displaying cells that display, respectively, the subject(s) or thought result(s), as described in page 14, lines 1-8, may be pieces of paper easy to be pasted on the paper or be peeled from it, as the case may be, allowing the arrangement of the thought results in accordance with any type of criterion. In accordance with other embodiments

of the invention, the medium for displaying words can be a display of a computer as described in page 5, line 18 to page 6, line 9. In accordance with these embodiments of the invention the word displaying cells as shown, for example, in Figure 4 would be displayed on the computer.

When amended claims 8 and 14 are properly construed they are directed to a machine. Also, as admitted by the Examiner, the device by itself is tangible and concrete. Therefore, the instrument for contemplation, as recited in amended claims 8 and 14 should be viewed as a machine, namely, an instrument for contemplation made up of at least the structures described in the specification. A machine is proper statutory subject matter within the meaning of 35 U.S.C. § 101. Therefore, the invention must be considered patentable subject matter even though it displays thought results. In fact, it is well established that "... a claim drawn to subject matter otherwise statutory does not become non-statutory simply because it uses a mathematical formula, computer program or digital computer." (*See* Diehr, 450 U.S., 209 U.S.P.Q. 1, 8). "Similarly, ... [a] process is not unpatentable simply because it contains a law of nature or a mathematical algorithm." (*Id.* 8). Moreover, "... when a claim containing a mathematical formula in a structure or process which, when considered as a whole, is performing a function which the patent laws were designed to protect (*e.g.*, transforming or reducing an article to a different state or thing), then the claims satisfies the requirements of § 101." (*Id.* 10) (emphasis added). Therefore, the fact that the claimed invention includes cells that display thought results and there is no limitation on the relationship between the thought results and the subject, this does not make the claimed invention fall outside the scope of patentable subject matter.

Moreover, "... a process, machine, manufacture, or composition of matter employing a law of nature, natural phenomenon, or abstract idea is patentable subject matter even though a law of nature, natural phenomenon, or abstract idea would not, by itself, be entitled to such protection. ... unless of course [it] does not produces a "useful, concrete and tangible result". (*See* Alappat, 33 F. 3d at 1544, 31 USPQ2d at 1557). The invention as recited in amended claims 8 and 14, relates to an instrument for selecting the best solutions and/or actions to be taken (thought results) to solve specific problems or achieve specific goals (subjects). The claimed invention accomplishes this by including structural elements that allow the arrangement of cells that display the best solutions and/or actions to be taken (thought results) for selecting

the best solutions and/or actions to be taken (thought results) to solve the specific problems or achieve the specific goals (subjects). The selection of the best solutions and/or actions to be taken, are useful, concrete, and tangible results produced by the claimed invention just like, for example, a final share price (*See* State Street Bank & Trust Co. V. Signature Financial Group Inc., 149 F. 3d 1368, 1373, 47 USPQ2d 1596, 1600 (Fed. Cir. 1998) or a smooth waveform displayed on a rasterizer monitor (*See* Alappat, 33 F. 3d at 1544, 31 USPQ2d at 1557) have been considered useful, concrete and tangible results. The best solutions and/or actions to be taken produced by the invention will provide the steps required to solve specific problems or accomplish specific goals. These steps might, for example, include a decision to expand the floor space of the shop in order to double the turnover in the next term as described in page 15, second paragraph, of the specification.

Finally, MPEP § 2106 IV B2(b) states that computer-related processes are statutory if the claimed process either (1) results in a physical transformation outside the computer or (2) is limited to a practical application within the technological arts. Further, for subject matter falling into (2) above, a claim is limited to a practical application when the method, as claimed, produces a concrete, tangible and useful result. See, the MPEP (page 2100-18, first column) for examples of statutory processes such as a computerized method of optimally controlling transfer, storage and retrieval of data between cache and hard disk storage devices such that the most frequently used data is readily available. Similarly, the current invention recited in amended claims 8 and 14, which relates to a method for arranging and retrieving data in accordance to a specific criteria, is a statutory type of claimed process.

Therefore, claims 8-17 are directed to statutory matter within the boundaries set by 35 U.S.C. § 101. Accordingly, withdrawal of this rejection is respectfully requested.

III. Rejection under 35 U.S.C. § 112

Claims 8-17 stand rejected under 35 U.S.C. § 112, first paragraph as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to make and/or use the invention. Specifically, the Examiner states that the term


"thought results" is indefinite because there is no limitation on the relationship between the thought results and the subjects. Claims 8 and 14 have been amended to include the limitation that the thought results are selected from the group consisting of solutions to solve the subject, actions to be taken to accomplish the subject, and keywords associated to the subject as described, for example, in pages 1, lines 19-21 or page 9, lines 6-8. This provides a definite, understandable definition of the term "thought results" as it is intended to be construed in the claims. Thus, this rejection is now moot. Accordingly, Applicant respectfully requests the withdrawal of the rejection.

CONCLUSION

Applicant believes this reply to be responsive to all outstanding issues and place the application in condition for allowance. If this belief is incorrect, or other issues arise, please do not hesitate to contact the undersigned or his associates at the telephone number listed below. Please apply any charges not covered, or any credits, to Deposit Account 50-0591 (Reference Number 09564/002001).

Respectfully submitted,

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